

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK MEISTER
AND JAMES RANDALL BECKERS

Appeal 2007-0288
Application 10/715,408
Technology Center 2100

Decided: March 27, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and JOSEPH L.
DIXON, *Administrative Patent Judges*.

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DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1-13, which are all of the pending claims.

We REVERSE and enter a New Grounds of Rejection under 37 C.F.R. 41.50(b).

BACKGROUND

Appellants' invention relates to an E-mail system with user send authorization. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An e-mail method, comprising:

recognizing whether a complete electronic mail message not created by a user and having a valid recipient address is to be sent, after a send function has been initiated, from a sending side to a receiving side;

alerting a system user on the sending side as to the message being sent; and

allowing the user to authorize sending of the message.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Chrabaszcz	US 6,073,133	Jun. 6, 2000
Rollins	US 6,434,601 B1	Aug. 13, 2002

REJECTIONS

Claims 1 and 6-13¹ stand anticipated under 35 U.S.C. §102 by Chrabaszcz.

Claims 1-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chrabaszcz in view of Rollins.

We note that Appellants and the Examiner provide a majority of their contentions and arguments regarding the objection to the Specification concerning new matter added to the instant claims. Most of Appellants arguments are with respect to the written description requirement under 35 U.S.C. § 112, first paragraph, but we note that the Examiner has never set forth a rejection under 35 U.S.C. § 112, first paragraph. We cannot address the objection to the Specification since this is beyond our jurisdiction, but our review of the instant prosecution leads us to the reasoned conclusion that the instant claim language lacks support in the original Specification and in the material incorporated by reference into the Specification.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Dec. 5, 2005) for the reasoning in support of the rejections of record, and to Appellants' Brief (filed Aug.

¹ We find that the Examiner did not specifically mention that independent claims 12 and 13 were included in the statement of the rejections under 35 U.S.C. §§ 102 and 103, but the cover sheet of the Final indicated these claims were rejected and these claims are similar to the other independent claims. Therefore, we interpret this as a typographical oversight and treat these claims with the other independent claims. Appellant appears to have also interpreted the Final Rejection in that manner.

25, 2005) and Reply Brief (filed Aug. 8, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. §§ 102 and 103

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. *See Studiengesellschaft Kohle, m.b.H. v. Dart*

Indus., Inc., 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Here, we find that the Examiner has not expressly identified where or how Chrabaszcz teaches the limitation “not created by a user” as the independent claims have been amended. Without such a showing, the Examiner has not discharged the initial burden to establish a prima facie of anticipation. Therefore, we cannot sustain the rejection of claims 1 and 6-13.

This deficiency carries through to the Examiner’s rejection under 35 U.S.C. § 103(a) and the Examiner has not identified how the teachings of Rollins remedy this deficiency. Nor has the Examiner identified how the combined teachings teach or suggest the limitation “not created by a user” as the independent claims have been amended. Therefore, we cannot sustain the rejection of claims 1-13.

Written Description Requirement vs. New Matter Objection

MPEP 2163.01 sets forth a good comparison of the Written Description Requirement and an objection to the specification for New Matter.

A written description requirement issue generally involves the question of whether the subject matter of a claim is supported by [conforms to] the disclosure of an application as filed. If the examiner concludes that the claimed subject matter is not supported [described] in an application as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph or denial of the benefit of the filing date of a previously filed application. The claim should not be rejected or objected to on the ground of new matter. As framed by the court in *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981), the concept of new matter is properly employed as a basis for objection to amendments to the

abstract, specification or drawings attempting to add new disclosure to that originally presented. While the test or analysis of description requirement and new matter issues is the same, the examining procedure and statutory basis for addressing these issues differ. See MPEP § 2163.06.

With this as a background, we enter a New Grounds of Rejection.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we have *sua sponte* set forth new grounds of rejection for claims 1-13.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The MPEP 2163.02 sets for the standard for determining compliance with the Written Description Requirement.

The courts have described the essential question to be addressed in a description requirement issue in a variety of ways. An objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an

applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by “whatever characteristics sufficiently distinguish it”).

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from,

addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C.112, first paragraph – description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate.

See MPEP § 2163 for examination guidelines pertaining to the written description requirement.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative limitation “not created by a user” in all independent claims 1, 6, 7, and 9-13 does not find express or implied support in the original Specification including the material from parent application 09/337,035.

Appellants’ arguments in the Brief including the definitions of virus and Trojan horse dated in the year 2005 are not relevant to the understanding of these terms at the time of the invention in June 1999 (Br. 6). We find these definitions are silent as to their relationship to a user. Therefore, Appellants' argument is not persuasive. We similarly find the discussion of the “unauthorized agent” silent as to a relationship to a “user” (Br. 3-6).

We find that the portions of the original Specification and claims, cited by Appellants, address the actuation of the send function rather than “not created by a user.” Appellants’ arguments also go to a “non-user”, but the claim language at issue is “not created by a user.” Furthermore, we find a distinction between an owner or non-owner as in the Specification and a user or non-user in the claim language. Therefore, Appellants’ argument is not persuasive.

We also find Appellants’ arguments concerning genus/species do not address the composition or creation of the message by a non-user. Therefore, Appellants’ argument is not persuasive. We have considered all of Appellants’ arguments advanced with respect to the objection to the Specification as they apply to our new grounds of rejection for a lack of written description, and we do not find them persuasive. Therefore, we have set forth a rejection above.

DECISION

In summary, we have reversed the Examiner’s rejection of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-13 is reversed.

We have entered a new grounds of rejection against claims 1-13 under 37 C.F.R. § 41.50(b).

As indicated *supra*, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (amended effective September 13, 2004, by final rule notice 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. & Trademark Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b)

provides that “A new ground of rejection . . . shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .
- (2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED.
37 C.F.R. § 41.50(b).

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